

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of Paul Bernell Finley Jr Serial No.: 10/782,675 Filed: 02/19/2004 Title: MODIFYING A DHCP CONFIGURATION FOR ONE SYSTEM ACCORDING TO A REQUEST FROM ANOTHER SYSTEM Docket: AUS90030948US1	: Before the Examiner: : Matthew E Kessler : Group Art Unit: 4121 : Amy J. Pattillo : P.O. Box 161327 : Austin, Tx 78716 : 512-402-9820
--	---

APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Briefs - Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This Appeal Brief is submitted in support of the Appeal in the above-referenced application pursuant to a Notice of Appeal filed August 26, 2008 as required by 37 C.F.R. 41.31. This is an appeal from a final rejection dated June 5, 2008 of Claims 1, 5, and 20 of application serial number 10/782,675, filed 02/19/2004.

I. Real Party in Interest

The real party in interest in the present application is the Assignee, International Business Machines Corporation of Armonk, New York, as evidenced by the Assignment set forth at Reel 014636, Frame 0250.

II. Related Appeals and Interferences

There are no Appeals or Interferences known to Appellant, Appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. No decisions have been rendered by a court or the Board in any related applications.

III. Status of Claims

1. Status of All Claims in Application

- a. Claims Rejected: 1, 5, and 20.
- b. Claims Allowed or Confirmed: None.
- c. Claims Withdrawn from Consideration: None.
- d. Claims Objected to: None.
- e. Claims Cancelled: 2-4 and 6-19.

2. Claims on Appeal

- a. The claims being appealed are: 1, 5, and 20.
- b. The claims being appealed stand finally rejected as noted by the Examiner in the Examiner's Action dated June 5, 2008. These rejected claims, which form the basis of this appeal, are reproduced in the attached Appendix.

IV. Status of Amendments

The Examiner finally rejected claims 1, 5, and 20 in a final office action dated June 5, 2008. In particular, the final office action dated June 5, 2008 rejected claims 1, 5, and 20 under 35 USC 102(b) as being unpatentable over Wilson (US Patent Publication 2001/0054101). No amendments to claims 1, 5, and 20, which are on appeal, were made following the final office action dated June 5, 2008.

V. Summary of Claimed Subject Matter

Claim 1 is directed to method for modifying a Dynamic Host Configuration Protocol (DHCP) server configuration for a dynamically configured system within a network. (Specification, page 1, paragraph 0011, lines 1-9). The method comprises the element of receiving a request from a first system to register for a lease time modification privilege at a daemon of the DHCP server, wherein the first system is an installation server for installing software on at least one dynamically configured system independent from the DHCP server, wherein the daemon of the DHCP server allows a plurality of systems to each register for at least one of a plurality of types of modification privileges at the DHCP server. (Specification, page 3, paragraph 0037, lines 1-6, page 3, paragraph 0038, lines 1-6, page 3, paragraph 0041, lines 1-5, page 3, paragraph 0042, lines 1-10, page 4, paragraph 0048, lines 1-11, and page 4, paragraph 0049, lines 1-11). In addition, the method comprises the element of responsive to the first system qualifying for modification privileges, storing by the daemon a record of the registration at the DHCP server for authenticating any modify packets received from the first system. (Specification, page 4, paragraph 0048, lines 1-11, and page 4, paragraph 0049, lines 1-11). In addition, the method comprises the element of receiving a first modify packet from the first system by the daemon of the DHCP server which manages a stored configuration file specifying a dynamic internet protocol (IP) address for the dynamically configured system, wherein the first modify packet requests an extension of a lease time of the dynamic IP address for the dynamically configured system for a duration of an installation on the dynamically configured system by the first system. (Specification, page 3, paragraph 0035, lines 1-7, page 3, paragraph 0036, lines 8-14, page 3, paragraph 0042, lines 1-10, and page 4, paragraph 0047, lines 1-10). In addition, the method comprises the element of responsive to the daemon confirming the first system as registered with the DHCP server, modifying by a service controller of the DHCP server the stored configuration file for the dynamically configured system according to the first modify packet received from

the first system, such that the first system is enabled to request modification of the configuration file for the dynamically configured system to maintain a same address for the dynamically configured system during the installation and the DHCP server controls the modification of the configuration file. (Specification, page 3, paragraph 0036, lines 9-15, page 3, paragraph 0042, lines 1-10, page 4, paragraph 0051, lines 1-7, and page 4, paragraph 0052, lines 1-10).

Claim 5 is directed to the method of claim 1 and is further directed to the element of receiving the first modify packet from the first system, wherein the modify packet specifies one from among a DHCP client, class and network, a particular option from among a plurality of DHCP options, and a value to assigned to the particular option. (Specification, page 4, paragraph 0053, lines 1-4 and Table 1, page 4, paragraph 0054, lines 1-3 and Table 2).

Claim 20 is directed to the method of claim 1 and is further directed to the element of receiving a second request from a second system to register for a second lease time modification privilege at the daemon of the DHCP server, wherein the second system maintains a database of a plurality of host computers and a separate IP address associated with each host computer and maintains a plurality of media access control (MAC) addresses for identifying each node in a network least one dynamically configured system independent from the DHCP server. (Specification, page 3, paragraph 0043, lines 1-6, page 3, paragraph 0044, lines 1-7). In addition, the method of claim 20 comprises the element of responsive to the second system qualifying for modification privileges, storing by the daemon a second record of the registration at the DHCP server for authenticating any modify packets received from the second system. (Specification, page 3, paragraph 0035, lines 1-7, page 3, paragraph 0043, lines 1-6, page 3, paragraph 0044, lines 1-7). In addition, the method of claim 20 comprises the element of receiving a second modify packet from the second system by the daemon of the DHCP server which manages a stored configuration file comprising a plurality of hostnames each matched to a separate MAC address, wherein the second modify packet requests updating a particular host name assigned to a particular MAC address in the stored configuration file.

(Specification, page 3, paragraph 0043, lines 1-6, page 3, paragraph 0044, lines 1-7). In addition, the method comprises the element of responsive to the daemon confirming the second system as registered with the DHCP server, modifying by the service controller of the DHCP server the stored configuration file for the particular MAC address according to the second modify packet received from the second system. (Specification, page 3, paragraph 0043, lines 1-6, page 3, paragraph 0044, lines 1-7).

VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1, 5, and 20 stand rejected under 35 U.S.C. §102(b) as being allegedly unpatentable over Wilson (US Patent Publication 2001/0054101).

VII. Argument

1. 35 U.S.C. 102(b), Alleged Anticipation by Wilson, Claims 1, 5, and 20

The Final Office Action rejects claims 1, 5, and 20 under 35 USC 102(b) as being allegedly unpatentable over Wilson (US Patent Publication 2001/0054101). [Final Office Action, p. 3] The rejection is respectfully traversed as follows. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Wilson does not teach each and every element of claims 1-5, and 20 or enable each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed. In addition, Appellants respectfully assert that the claims do not all stand or fall together.

Claim 1

Claim 1 reads:

1. A method for modifying a Dynamic Host Configuration Protocol (DHCP) server configuration for a dynamically configured system within a network, comprising:
 - receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server, wherein said daemon of said DHCP server allows a plurality of systems to each register for at least one of a plurality of types of modification privileges at said DHCP server;
 - responsive to said first system qualifying for modification privileges, storing by said daemon a record of said registration at said DHCP server for authenticating any modify packets received from said first system;
 - receiving a first modify packet from said first system by said daemon of said DHCP server which manages a stored

configuration file specifying a dynamic internet protocol (IP) address for said dynamically configured system, wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first system; and

responsive to said daemon confirming said first system as registered with said DHCP server, modifying by a service controller of said DHCP server said stored configuration file for said dynamically configured system according to said first modify packet received from said first system, such that said first system is enabled to request modification of said configuration file for said dynamically configured system to maintain a same address for said dynamically configured system during said installation and said DHCP server controls the modification of said configuration file.

Appellants respectfully assert that Wilson fails to teach or enable each and every element of claim 1 because Wilson does not teach or enable the elements of: (1) receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server, wherein said daemon of said DHCP server allows a plurality of systems to each register for at least one of a plurality of types of modification privileges at said DHCP server; (2) receiving a first modify packet from said first system by said daemon of said DHCP server which manages a stored configuration file specifying a dynamic internet protocol (IP) address for said dynamically configured system, wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first system.

Appellants note that the arguments presented herein have not been previously presented because Wilson was first cited by the Examiner in the rejection in the Final Office Action. Appellants note that Wilson describes a server system for hotels that allows guests to receive temporary, billed, network service from the hotel server system. *Wilson*, abstract. The abstract of Wilson specifically describes "the invention allows users to plug into the network and

access not only the network that their computer is connected to but also to the Internet, the WWW and the individual's email." *Wilson*, abstract.

receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server, wherein said daemon of said DHCP server allows a plurality of systems to each register for at least one of a plurality of types of modification privileges at said DHCP server

Appellants respectfully submit that *Wilson* fails to teach or enable each and every element of receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server, wherein said daemon of said DHCP server allows a plurality of systems to each register for at least one of a plurality of types of modification privileges at said DHCP server because *Wilson* does not teach or enable an installation server for installing software on at least one dynamically configured system independent of the server system. The Final Office Action states, with regard to the element of receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server, that "it is inconsequential that the first system happens to be an "installation server" as opposed to any other system which make the identical type of DHCP request. The method described in claim 1 is for the modification and assignment of IP's at a DHCP server. Furthermore, any of the clients recited in *Wilson* could be interpreted as installation servers since any PC client can provide installation services to itself or other systems within the network." [Final Office Action, p. 3]

Appellants respectfully submit that the Examiner has erred by rejecting claim 1 as anticipated by *Wilson* under 35 USC 102(b), but not considering each and every element of claim 1. In particular, Appellants respectfully note that a

claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). The Examiner states in the Final Rejection that first system happening to be an installation server is "inconsequential". [Final Office Action, p. 3] Neither 35 USC 102(b) or case law provides a basis for an Examiner to determine that an element of a claim is inconsequential.

In addition, Appellants respectfully submit that the Examiner has erred in rejecting claim 1 as anticipated by Wilson because Wilson fails to explicitly teach each and every element of receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server. Clearly, Wilson does not explicitly teach an installation server for installing software on at least one dynamically configured system independent from the DHCP server. The Examiner does not point to any explicit teach, and Wilson when reviewed as a whole does not teach an installation server.

Further, Appellants respectfully submit that the Examiner has erred in rejecting claim 1 as anticipated by Wilson because Wilson fails to inherently teach each and every element of receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server. The Examiner interprets the "installation server" element of claim 1 as inconsequential as opposed to any other system which makes a DHCP request, and then also interprets any client of Wilson as teaching an "installation server". [Final Office Action, p. 3] Neither of these grounds of rejection state a rationale or provide evidence which rise to the level required of an inherent teaching of wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server. In particular, Appellants note that "the fact that a certain result or characteristic may

occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Appellants respectfully submit that the stated rejection, which disregards the installation server element as inconsequential to the claim, and subsequently asserts that any client in Wilson could be an installation server, does not rise to the level of providing "extrinsic evidence that makes it clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In addition, Appellants respectfully submit that Wilson does not in fact inherently teach wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server.

receiving a first modify packet from said first system by said daemon of said DHCP server which manages a stored configuration file specifying a dynamic internet protocol (IP) address for said dynamically configured system, wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first system

Appellants respectfully subject that Wilson fails to teach or enable each and every element of receiving a first modify packet from said first system by said daemon of said DHCP server which manages a stored configuration file specifying a dynamic internet protocol (IP) address for said dynamically configured system, wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first

system because Wilson does not teach or enable, explicitly or inherently, wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first system. As to the element of receiving a first modify packet from said first system by said daemon of said DHCP server which manages a stored configuration file specifying a dynamic internet protocol (IP) address for said dynamically configured system, wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first system, the Final Office Action cites paragraph 0118 of Wilson as reading on the element and as describing “teaches the DHCP server receiving requests for IPs and leasing IPs.” [Final Office Action, p. 4]

Paragraph 0118 of Wilson reads:

An embodiment of the present invention involves the use in the hotel industry. The primary objective is to provide guests with the ability to log into the Internet from their hotel rooms without having to modify their personal mobile computer network settings. The guests will be able to transparently and seamlessly get their email, surf the web, and carry out their normal Internet activities.

Appellants respectfully submit that Wilson fails to teach or enable wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first system because regardless of which client of Wilson the Examiner associates with the first system of claim 1, none of these clients in Wilson requests an extension of a lease time for a duration of an installation on the dynamically configured system by the installation system. As previously noted, none of the systems in Wilson are installation servers for installing software on at least one dynamically configured system independent from said DHCP server. In addition, clearly, there is no system in Wilson that qualifies as installation server as taught in claim 1 as a whole which requires a modify packet request for an extension of a lease time of

a dynamic IP address for a dynamically configured system for a duration of an installation on the dynamically configured system by the installation server.

Claims 5 and 20

Further, each of claims 5 and 20 depend, directly on allowable independent claim 1. Therefore, Appellants respectfully request allowance of claims 5 and 20 for at least the same reasons that claim 1 is allowable as discussed above.

CONCLUSION

It is therefore respectfully requested that the Examiner's rejection of claims 1, 5, and 20 under 35 U.S.C. §102(b) be reversed and the claims allowed.

Please charge the fee of \$510.00 for submission of an Appeal Brief under 37 CFR 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0447. No additional filing fee is believed to be necessary; however, in the event that any additional fee is required, please charge it to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

By /Amy J. Pattillo, Reg. No. 46,983/
AMY J. PATTILLO
Registration No. 46,983
P.O. BOX 161327
AUSTIN, TEXAS 78716
ATTORNEY FOR APPELLANTS
Telephone: 512-402-9820
Facsimile: 512-306-0417

VIII. Claims Appendix

The Claims involved in the Appeal are as follows:

1. A method for modifying a Dynamic Host Configuration Protocol (DHCP) server configuration for a dynamically configured system within a network, comprising:

receiving a request from a first system to register for a lease time modification privilege at a daemon of said DHCP server, wherein said first system is an installation server for installing software on at least one dynamically configured system independent from said DHCP server, wherein said daemon of said DHCP server allows a plurality of systems to each register for at least one of a plurality of types of modification privileges at said DHCP server;

responsive to said first system qualifying for modification privileges, storing by said daemon a record of said registration at said DHCP server for authenticating any modify packets received from said first system;

receiving a first modify packet from said first system by said daemon of said DHCP server which manages a stored configuration file specifying a dynamic internet protocol (IP) address for said dynamically configured system, wherein said first modify packet requests an extension of a lease time of said dynamic IP address for said dynamically configured system for a duration of an installation on said dynamically configured system by said first system; and

responsive to said daemon confirming said first system as registered with said DHCP server, modifying by a service controller of said DHCP server said stored configuration file for said dynamically configured system according to said first modify packet received from said first system, such that said first system is enabled to request modification of said configuration file for said dynamically configured system to maintain a same address for said dynamically configured system during said installation and said DHCP server controls the modification of said configuration file.

5. The method according to claim 1 for modifying a DHCP configuration, wherein receiving a first modify packet from a first system further comprises:

receiving said first modify packet from said first system, wherein said modify packet specifies one from among a DHCP client, class and network, a particular option from among a plurality of DHCP options, and a value to assigned to said particular option.

20. The method according to claim 1 for modifying a DHCP configuration, further comprising:

receiving a second request from a second system to register for a second lease time modification privilege at said daemon of said DHCP server, wherein said second system maintains a database of a plurality of host computers and a separate IP address associated with each host computer and maintains a plurality of media access control (MAC) addresses for identifying each node in a network least one dynamically configured system independent from said DHCP server;

responsive to said second system qualifying for modification privileges, storing by said daemon a second record of said registration at said DHCP server for authenticating any modify packets received from said second system;

receiving a second modify packet from said second system by said daemon of said DHCP server which manages a stored configuration file comprising a plurality of hostnames each matched to a separate MAC address, wherein said second modify packet requests updating a particular host name assigned to a particular MAC address in said stored configuration file;

responsive to said daemon confirming said second system as registered with said DHCP server, modifying by said service controller of said DHCP server said stored configuration file for said particular MAC address according to said second modify packet received from said second system.

IX. Evidence Appendix

There is no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner that is relied upon by Appellants in the appeal.

X. Related Proceedings Appendix

There are no decisions rendered by a court or the Board in any related appeals.